



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/776,583

02/10/2004

Michael Lax

AUT/015

3036

1473 7590 10/23/2009

ROPES & GRAY LLP  
PATENT DOCKETING 39/361  
1211 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036-8704

EXAMINER

NGUYEN, THUY-VI THI

ART UNIT

PAPER NUMBER

3689

MAIL DATE

DELIVERY MODE

10/23/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/776,583	<b>Applicant(s)</b> LAX, MICHAEL	
	<b>Examiner</b> THUY-VI NGUYEN	<b>Art Unit</b> 3689	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 June 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) 44-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This is in response to the applicant's communication filed on 23 June, 2009

wherein:

Claims 1-60 are currently pending

Claims 44-60 have been withdrawn;

Claims 1, 23, 32 have been amended.

Independent claim 1 as on 23 June, 2009 is amended as follow:

An apparatus for use with a benefit denial system, said apparatus comprising:

a containing element configured to receive an asset, said asset comprising a benefit for a user of said asset; and

an electrical circuit, enclosed within the containing element, comprising an antenna, said circuit operatively associated with said containing element and configured to communicate from inside the containing element, information corresponding to said asset\_ to a receiver outside said containing element;

wherein said information is configured to be used by said benefit denial system to provide said benefit to said user .

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1 and 23 recites the last step " *wherein said information is configured to be used by said benefit denial system to provide said benefit to said user*", It is not clear how the communicated "information/data" can be configured to provide the benefit to the user. For example, if the communicated information/data is a phrase "purchasing a CD" by "John" then, how would this "phrase" are configured to provide the benefit to the user?

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-2, 5-19, 22-43** are rejected under 35 U.S.C. 102(e) as anticipated by

HOGEN ESCH (EP 1,225,585 A1) Publication date : 07/24/2002

Art Unit: 3689

**As for independent claim 1**, HOGEN ESCH discloses an apparatus, said apparatus comprising:

a containing element configured to receive an asset, said asset comprising a benefit for a user of said asset; and

{see figure 1, pars. 0001-0002, 0011 wherein HOGEN ESCH discloses a CD or DVD box (containing element) for storing information (benefit) carrier in the form of CD or DVD} .

an electrical circuit, enclosed within the containing element, comprising an antenna, said circuit operatively associated with said containing element and configured to communicate from inside the containing element, information corresponding to said asset\_ to a receiver outside said containing element

{see figures 1-2, elements 22, 24, pars. 0011, 0014, 0022-0023 wherein HOGEN ESCH discloses a transponder circuit (22), and a coil or antenna (24) are attached in the CD box. Information stored in *the identification label of the label (8) provided on the CD or DVD are transferred (communicated) via the transponder circuit 22* (from inside the box or containing element) *to the noncontact radiofrequency antitheft system (18)* (to a receiver).

wherein said information is configured to be used by said benefit denial system

{see pars. Par. 0022-0023. 0027 disclose the information is configured for the antitheft of the product or CD or DVD}.

Note: it appears independent 1 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While

Art Unit: 3689

features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Also, this is an apparatus claim and intended use limitation for the system/device or apparatus, i.e. “*for use with a benefit denial system...*; and “*to be used by said benefit denial system to provide said benefit to said user*” of the last step have no patentable weight in an apparatus claim.

**As for dep. claim 2**, which discloses a locking element configured to lock the containing element in a close state, this is taught in HOGEN ESCH, par. 0007.

**As for dep. claim 5**, which discloses the electrical circuit is affixed to the containing element, this is taught in HOGEN ESCH, see figure 1, pars. 0011, 0014, 0022-0023.

**As for dep. claim 6**, which deals with the feature said electrical circuit is disposed inside said containing element when said containing element is closed; and said electrical circuit is configured to communicate said information when said

Art Unit: 3689

containing element is closed , this is taught in HOGEN ESCH, see figures 1-2, elements 22, 24, pars. 0011, 0014, 0022-0023.

**As for dep. claim 7**, which deals with the feature said circuit comprises a data storage device, this is taught in HOGEN ESCH, see pars.0014, 0022-0025.

**As for dep. claim 8**, which deals with the feature, said circuit is further configured to communicate said information when said asset is enclosed within said containing element, this is taught in HOGEN ESCH, see pars. 0022-0025.

**As for dep. claims 9-11**, which deals with the feature said asset has a type; and said element is configured to enclose no more than three assets of said type, no more than two assets of said type , or no more than one asset of said type, this is taught in HODE, {figures 1-2, pars. 0001-0002, 0011} Furthermore, the term “type of asset” is not a structural element or functional structure and has no patentable weigh in an apparatus claim. See MPEP 2106.01.

**As for dep. claims 12-16**, which deals with the feature said information is required by said system to provide said benefit e.g. executable computer program, a game, audio data, visual data. It is noted that these features are deal with type of benefit information/data which are considered as nonfunctional descriptive material and carried no patentable weights in the system claim. See MPEP 2106.01.

**As for dep. claims 17-18** deals with “the benefit data/information that are inactive before said system receives a portion of said information; and said system is configured to activate said data, the data are configured to be accessed using an access device; the system is configured to provide after receiving said portion, a data

Art Unit: 3689

key to said device, said key configured to activate said data” are considered as the intended use which doesn't change the structure of the positively recited elements of a containing element comprising a circuit and an antenna. Thus this intended use limitations have no patentable weight in an apparatus claim. Furthermore, this type of information are considered as nonfunctional descriptive material and carried no patentable weights. See MPEP 2106.01.

**As for claim 19**, which deals with information comprise security data configured to be communicated by a user and transaction data configured to be communicated by the receiver” are considered as the intended use which doesn't change the structure of the positively recited elements of a containing element comprising a circuit and an antenna. Thus this intended use limitations have no patentable weight in an apparatus claim. Furthermore, this type of information are considered as nonfunctional descriptive material and carried no patentable weights. See MPEP 2106.01.

**As for claim 22**, which deals with type communication using a radio frequency signal, this is fairly taught in HODES, see at least pars. 0070, 0012-0013.

**As for independent claim 23**, which discloses a container which carries the similar structure element as independent claim 1 above. Therefore, it is rejected for the same reason sets forth the rejected independent claim above.

More over, Note: it appears independent 22 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in



Art Unit: 3689

terms of structure rather than function. See MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Also, this is an apparatus claim and intended use limitation for the system/device or apparatus, i.e. "*for use with a system for executing a conveyance of an interest in an asset from a first party to a second party*"; and "*where said information is configured to be used by said system to execute said conveyance*" have no patentable weight in an apparatus claim.

**As for dep. claims 24-25**, which have the similar limitation as the rejected dep. claims 6 and 8 above. Therefore, it is rejected for the same reason sets forth the rejected dep. claims 6 and 8 as stated above.

**As for dep. claims 26-27**, which discloses the information is required by the system to execute said conveyance is considered as the intended use which doesn't change the structure of the positively recited elements of a container comprising a circuit and an antenna. Thus this intended use limitations have no patentable weight in an apparatus claim. Furthermore, this type of information is considered as nonfunctional descriptive material and carried no patentable weights. See MPEP 2106.01.

Art Unit: 3689

**As for dep. claim 28-29** which discloses wherein “an interest is an ownership of interest and said interest comprise a right to use said asset” is considered as the intended use which doesn't change the structure of the positively recited elements of a container comprising a circuit and an antenna. Thus this intended use limitations have no patentable weight in an apparatus claim.

**As for the dep. claims 30-31** which discloses “the circuit is configured to communicate said information before a third party surrenders said asset to said second party, and the second party does not hold an ownership interest in said asset during conveyance” is considered as the intended use which doesn't change the structure of the positively recited elements of a container comprising a circuit and an antenna. Thus this intended use limitations have no patentable weight in an apparatus claim.

**As for independent claim 32**, HOGEN ESCH discloses a container, said container comprising:

a containing element configured to receive an asset, said asset comprising a benefit for a user of said asset; and

{see figure 1, pars. 0001-0002, 0011 wherein HOGEN ESCH discloses a CD or DVD box (containing element) for storing information (benefit) carrier in the form of CD or DVD} .

an electrical circuit, enclosed within the containing element, comprising an antenna, said circuit operatively associated with said containing element and configured

Art Unit: 3689

to communicate from inside the containing element, information corresponding to said asset, to a receiver outside said containing element

{see figures 1-2, elements 22, 24, pars. 0011, 0014, 0022-0023 wherein HOGEN ESCH discloses a transponder circuit (22), and a coil or antenna (24) are attached in the CD box. Information stored in *the identification label of the label (8) provided on the CD or DVD are transferred (communicated) via the transponder circuit 22* (from inside the box or containing element) *to the noncontact radiofrequency antitheft system (18)* (to a receiver);

a circuit deactivator configured to interrupt electrical communication within said circuit

{see figures 1-2, pars 0014, 0018-0022, 0029 discloses “the label 8 has been deactivated, proceeds through the intermediacy of the transponder circuit 22 }.

**As for claim 33**, which deals with said electrical circuit is disposed inside said containing element when said containing element is closed; and said electrical circuit is configured to communicate said information when said containing element is closed, this is fairly taught in HOGEN ESCH {see pars.0014, 0022-0023 }.

**As for claim 34**, which deals with the said circuit is configured to communicate said information when said asset is enclosed within said containing element, this is fairly taught in HOGEN ESCH, {see at least pars. see pars. 0022-0025}.

**As for claim 35**, which deals with the interrupt electrical signal communication between two circuit devices, this is fairly taught in HOGEN ESCH, see figures 1-2, pars. 0022-0025, 0029.

Art Unit: 3689

**As for claims 36-37**, which deals with the first portion, comprises a data storage device and second portion comprises an antenna, this is taught in HOGEN ESCH, see figures 1-2, at least pars. 0022-0025, 0029.

**As for claims 38-39**, which deal with the deactivator is configured to interrupt said electrical communication by physically separating said first and second portions of said circuit, and manually configuration, this is fairly taught in this is taught in HOGEN ESCH, see figures 1-2, at least pars. 0022-0025, 0029.

**As for claims 40-43**, which deal with “the information is configured to be used by a benefit denial system to provide to an asset user access to a benefit and the information is required by said benefit denial system to provide said access” is considered as the intended use which doesn't change the structure of the positively recited elements of a containing element comprising a circuit, an antenna and a circuit deactivator. Thus this intended use limitations have no patentable weight in an apparatus claim. Furthermore, this type of information are considered as nonfunctional descriptive material and carried no patentable weights. See MPEP 2106.01.

Art Unit: 3689

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims **3, 20-21** is rejected under 35 U.S.C. 103(a) as being unpatentable over HOGEN ESCH (EP 1,225,585 A1) Publication date : 07/24/2002

**As for dep. claim 3**, HOGEN ESCH discloses the claimed invention as stated above. For example, HOGEN ESCH discloses the electrical circuit is affixed in side the box, or containing element. However, HOGEN ESCH doesn't mention about the position of the circuit is affixed to the locking containing element. It would have been obvious to one of ordinary skill in the art to locate/mount the electronic circuit feature either in the container or attach to the locking element of the container or any other place in the device or container to achieve the same results such as preventing the theft access in side the container or using the item/asset in side the container will be denied .

**As for claims 20-21**, HOGEN ESCH discloses the claimed invention as stated above. For example, HOGEN ESCH discloses a CD or DVD box (containing element). HOGEN ESCH doesn't mention about the material that made the CD or DVD box. However, these type of optical opaque material is old and well known in the art. It would have been obvious to one of ordinary skill in the art to recognize the CD or DVD or the video tape box is made by the optically opaque material.

Art Unit: 3689

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over HOGE ESCH and in view of LAX (US 5,598,728)

**As for dep. claim 4**, which deals with the feature said locking element is removable from said containing element. HODES discloses all the limitation as stated above, HODES further disclose the security container/device having a locking feature except for the “the locking feature is removable”. LAX disclose a similar security device/case/package having a removable locking element {see figure 4, col. 3, liens 29-30}. It would have been obvious to one of ordinary skill in the art to modify the system of HODES to include the removable locking element as taught by LAX for the benefit of customer convenience usage.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-43 have been considered and are responded as follows:

1) In response to the 112 rejection, applicant's comment that “functions” of the information or “intended use” such as “activation information” can be configured to provide the benefit to the user. Again, data are data and they are represented by bits 010101 on a computer for data processing or communication exchange. One cannot configure the data to be used by said “benefit denial system” to provide benefit to the user as shown in claim 1. For example, the term “activation” information or data, they are considered as non-functional descriptive material (NFDM) on the data of “...”, thus having no patentable weight. The mere insertion of “activation” data over “data” does

Art Unit: 3689

not “impart functionality when employed as a computer component”, thus having no patentable weight.

See MPEP 2106.01 “Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Furthermore, Claim 1 is an apparatus claim which requires “structural elements” or structures. The “wherein” clause with intended use clause “is configured” and “to be used” and “to provide” do not have any structural limitations and should not have any patentable weight in an apparatus claim.

2) In response to the 102/103 rejections, the arguments are moot in view of the new grounds of rejections which are caused by applicant’s amendment of the claims.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



Art Unit: 3689

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689  
10/21/09